

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARTIN A. MAURINUS and  
WILBERT F. JANSON JR.

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Appeal No. 1998-0660  
Application No. 08/584,501

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ON BRIEF

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Before HAIRSTON, FLEMING, and HECKER, Administrative Patent Judges.

HECKER, Administrative Patent Judge.

***DECISION ON APPEAL***

This is a decision on appeal from the final rejection of claims 1 through 11, all claims pending in this application.

The invention relates to a system of electronic digital cameras for capturing images of customers. An



admitted prior system allows customers participating in rides at a theme park to select and obtain a print of an image of themselves on the ride. All equipment is located at the particular ride. The disclosed invention provides for a customer identification device for the customer to selectively activate the camera. Upon selection, the digital image and customer identification are transmitted to a central image processor via a high bandwidth network. An output station, also connected to the network, allows the customer to display, select and print images at a later time and place. The output station includes a customer identification device to access images associated with the identified customer. The system of the present invention reduces the number of output devices that are needed by providing a central output device that can be fed by a plurality of image capture devices. Since the output station may be located in a convenient location remote from the theme park, such as in a hotel adjacent the theme park, the customer is freed from carrying around pictures and can order the prints at leisure.

Independent claim 1 is reproduced as follows:



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1. A system for electronic photography, comprising:
  - a. a plurality of image capture stations, each station including a digital camera and a customer identification device for selectively actuating the digital camera, by the customer, to capture a digital image and recording customer identification with the digital image;
  - b. a central image processor for collecting and storing the digital images captured by the image capture stations;
  - c. a central controller;
  - d. a high bandwidth communications network connecting the image capture stations to the central controller, the central controller controlling access to the network;
  - e. an output station connected to the central image processor by the high bandwidth communications network, the output station including a customer identification device, a display device responsive to actuation of the customer identification device to display the digital images associated with the customer identification, and means for the customer to select images to be transferred to an output medium; and
  - f. an output device connected to the central image processor by the high bandwidth communications network for transferring the digital images to the output medium.

The Examiner relies on the following references:

Gordon et al.	5,291,302	Mar. 1, 1994
Maeda et al.	5,349,452	Sep. 20, 1994

Appellants' Admitted Prior Art (APA)

Claims 1 through 11 stand rejected under 35 U.S.C.



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§ 103 as being unpatentable over APA in view of Maeda and Gordon. Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the brief and answer for the respective details thereof.

### **OPINION**

After a careful review of the evidence before us, we will not sustain the rejection of claims 1 through 11 under 35 U.S.C. § 103.

The Examiner has failed to set forth a ***prima facie*** case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237,



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1239 (Fed. Cir. 1995) (***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984))).

With respect to claim 1, the Examiner reasons that APA teaches the claimed system with "selectivity" in performing these operations being inherent (answer-page 3). The Examiner explains that the inherent "selectivity" exists inasmuch as the customer selects whether or not to enter a ride equipped with the described photographing system; or alternatively, to provide the customer with the option of whether or not to be photographed in order to avoid objections by customers who choose not to be photographed would be an expedient obvious to one of ordinary skill in the art (answer-page 4).

The Examiner acknowledges that APA does not provide a networking element, in which several capture stations feed images to one output station and hardware supporting this operation. The Examiner cites Maeda for this teaching in that Maeda collects and stores digital images using a network connecting digital image sources to a central controller and output device (answer-pages 3 and 4).



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Noting that Maeda does not specify the recording of customer identification with the digital image, the Examiner states:

The recording of an identification for the person who is to receive a given image in a system that handles many images for many recipients is clearly useful to get each image to the right destination; the recording of such ID data for each image is shown for example in Gordon et al. The use of customer identification recording to insure that each image reaches the right person in the system of Applicant's prior art as modified for a network environment in view of Maeda et al. would be an expedient obvious to one of ordinary skill in the art. [Answer-pages 4 and 5.]

Appellants argue there is no motivation for the suggested modifications and combination.

As to the claimed "selectively actuating the digital camera", Appellants have not addressed the Examiner's inherency theory, i.e., the customer selects whether to enter a ride or not. We find this theory to be a far stretch; selective entry to a ride is a far cry from selective camera activation as claimed.

As to the Examiner's alternative explanation, i.e., providing a customer with the option of being photographed in order to avoid objections by customers who choose not to be



photographed would be an obvious expedient, Appellants argue no such objections have been experienced by the inventors.

The expressed inventors' "experience" is unsupported by evidence (e.g., an affidavit), thus such experience can not be evaluated. Nonetheless, the Examiner's position is just as speculative, being supported solely by some "obvious expedient"<sup>1</sup>.

At this point we note that Appellants have not contested the combination of APA with Maeda (for the network, etc.) and Gordon (for customer identification). Appellants proceed to argue that Maeda and Gordon do not provide all the claimed elements.

One missing element argued is "a customer identification device for selectively actuating a digital camera." We have covered this item supra, and agree with Appellants that the art discloses none.

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<sup>1</sup> We note however, that the Examiner is correct in that his expressed motivation need not be the same as Appellants' motivation. However, the Examiner has not responded to Appellants' contention that the Examiner's expressed motivation is nonexistent based on customer experience.



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Another missing element argued is "recording customer identification with the digital image." The Examiner responds:

[T]he image source device in the Gordon et al. system clearly must record customer PINs in order to correctly recognize valid and invalid supplied PINs. [Answer-page 8.]

We do not agree. The PIN supplied at the receiving end of Gordon need not be transmitted with the image document. The receiving FAX machine may be programmed to recognize the recipient's PIN for **any** secured document received. Since the Examiner has not indicated where Gordon discloses sending the PIN with the image document, it is not at all "clear" as alleged by the Examiner.

Another missing element argued is "a display device responsive to actuation of the customer identification device." Although it is understood that APA provides a display device, the Examiner has not shown how the art teaches or would have suggested the display being responsive to a customer identification device. The only identification alleged by the Examiner is with regard to the recipient of a secured FAX via a PIN.



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The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." ***Para-Ordnance Mfg. v. SGS Importers Int'l***, 73 F.3d at 1087, 37 USPQ2d at 1239, ***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

As pointed out above, many of the limitations of claim 1 are missing, motivation is lacking for the suggested modification of "selectively actuating" and, we might add, there is no clear and adequate motivation to combine the cited references (although the basic combination of Maeda and Gordon was not challenged by Appellants). Thus, we will not sustain the Examiner's rejection of claim 1.



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The remaining claims on appeal also contain the above limitations discussed in regard to claim 1 and thereby, we will not sustain the rejection as to these claims.

We have not sustained the rejection of claims 1 through 11 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

***REVERSED***

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
STUART N. HECKER	)	
Administrative Patent Judge	)	

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***Leticia***

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APJ HECKER

APJ HAIRSTON

APJ FLEMING

DECISION:

Send Reference(s): Yes No  
or Translation (s)

Panel Change: Yes No

Index Sheet-2901 Rejection(s):

Prepared: June 7, 2001

Draft                  Final

3 MEM. CONF.    Y                  N

OB/HD                  GAU

PALM / ACTS 2 / BOOK  
DISK (FOIA) / REPORT